

Original U.S. Patent No. 5,634,706  
Serial No. 09/323,636  
Applicant - James E. Barry  
Art Unit (Examiner) - 2875 (Quach)  
Title: ILLUMINATED GAS TANK OR SHELL

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concl'd  
12/23/02  
the motorcycle.

REMARKS

This Amendment is responsive to the Office Action dated April 24, 2002. In that Action, the objected to the specification and claims 18, 19, 23, 24, 28 and 33. Claims 17, 20, 21, 26, 28-30, 32 and 33 were rejected under 35 U.S.C. §112, second paragraph. Claims 17, 20 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Helm. Claims 17, 18, 20 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lichon in view of Helm. Claims 22, 23 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lichon in view of Helm. Claims 26 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lichon in view of Helm. Claims 17, 27, 29 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hamilton. Claims 32 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lichon in view of Helm. Applicant respectfully traverses the Examiner's rejections.

Claims 19, 24 and 30 did not have any earlier patents cited against their subject and claim 30 was specifically indicated to

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contain allowable subject matter if rewritten in independent form.

Claims 1-16 are allowed.

The specification has been amended to overcome the Examiner's objections. Support for specification amendments can be found in the claims and as previously indicated by Applicant in earlier responses.

Claims 17, 18, 22, 27, 30 and 32 have been amended. No new matter has been inserted. In compliance with 37 C.F.R. §1.173(c), Applicant respectfully states the claims 1-33 remain pending in the application.

The claims have been amended to overcome all Section 112 rejections. Allowable claim 30 has been rewritten into independent form.

Applicant respectfully incorporates by reference its previous comments regarding support for the new claim language. Furthermore, it is readily evident from the drawings that the body member is adapted for attachment to a frame of the motorcycle where a motorcycle gasoline tank is normally disposed.

Applicant respectfully disagrees with the Examiner's objections to the claims, as claims 17, 18, 22, 23, 26 and 32 are

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generic to all three embodiments identified by the Examiner.

For a Section 103(a) rejection it is required that the cited references be proper prior art. For determining whether prior art is "analogous" and thus proper, two criteria are looked out: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference is still reasonably pertinent to the particular problem with which the inventor is involved. In re Clay, 966 F.2d 656, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992). Where a reference is directed to a different purpose, the inventor will have less motivation or occasion to consider it. Id. As will be shown below, Applicant respectfully submits that none of the three references satisfy the criteria established by the Federal Circuit and are thus non-analogous art.

#### Helms

The field of endeavor for Helms is the problem of mounting lights and signs to objects having curved surfaces. Helms particularly address a device for mounting lights and magnetic sheets on curved shaped objects which are being towed by a

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separate vehicle (Col. 4, lines 16-22). Applicant's field of endeavor is providing increased visibility, especially at nighttime, for the motorcycle driver of his or her adjacent front and front half side surroundings. This field of endeavor is significantly different than Helms' field of endeavor. Furthermore, Helms is not pertinent to the particular problem that Applicant's invention addresses. Additionally, the towed large gasoline storage tank shown in Helms is not the same or equivalent to a motorcycle gas tank or hollow body shell defined and relevant to Applicant's invention. Helms has nothing to do with motorcycles or motorcycles gasoline tanks. Accordingly, Helms fails to meet either criteria and is non-analogous art.

Hamilton

For similar reasons, Hamilton also fails the two part non-analogous art test. Hamilton has nothing to do with motorcycles or motorcycle gasoline tanks. Hamilton is also not pertinent to illuminating the adjacent front and front half side surroundings of a motorcycle. Hamilton also has nothing to do with attaching light assemblies to motorcycle gasoline tanks to achieve the desired front surroundings illumination. Accordingly, Hamilton

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fails to meet either criteria and is non-analogous art.

Lichon

Though, Lichon concerns generally a motorcycle, Applicant respectfully submits that Lichon also fails the two part test. The problem being address by Applicant is the rider's poor visibility at nightttime of his adjacent surroundings. Applicant solves this long-felt problem by attaching an illumination member or assembly to the motorcycle gasoline tank. Lichon fails to address the rider's poor visibility problem and is provided to improved third party visibility of the motorcycle. Furthermore, attaching a signal device on a post at the back of the motorcycle to dispose the signal device way up high is clearly unimportant to Applicant's invention. There must be more than the cited reference generally involving a motorcycle for it to be analogous art. However, Applicant respectfully submits that the "more" needed fails to exist with Lichon. Accordingly, Lichon fails to meet either criteria and is non-analogous art.

In addition to the above non-analogous art arguments, Applicant will address below the merits of the cited references:

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Claims 17, 20 and 21 - Section 103(a) (Helms)

Clearly the gas tank disclosed by Helms is completely different than the motorcycle gas tank or hollow body shell disclosed and claimed by Applicant. To further distinguish Applicant's invention, Applicant has now specifically claimed in Claim 17 that the body member is adapted for attachment to the motorcycle frame where a motorcycle gasoline tank is normally disposed. Helms concerns large gasoline storage tankers which are towed by a separate vehicle. Helms gasoline tankers are not attached to motorcycle frames and are completely different than a motorcycle gasoline tank or hollow body shell. One does not tow a motorcycle gasoline tank or hollow body shell.

Claims 17, 18, 20-23, 25, 26, 28, 32 and 33 - Section 103(a)  
(Lichon and Helms)

Though Lichon shows a motorcycle and the motorcycle's gasoline tank, the illumination member of Lichon has nothing to do with the motorcycle's gasoline tank. Rather the illumination member is attached at the back of the motorcycle to a post so that it extends up high. This position allows it to be easily seen at nighttime by third parties. The Lichon illumination member is not

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used for illuminating the adjacent ground area. Furthermore, attaching the illumination member to the motorcycle gasoline tank, not to a post, would effect third parties' visibility of the illumination member. Thus, one would not be motivated to move the illumination member so that it is attached to the gasoline tank. Additionally, as pointed out above, the gasoline tank of Helms is completely different than a motorcycle gasoline tank. There is absolutely no motivation or suggestion in either of these references for the proposed combination. Even if proper, the proposed combination would not still disclose Applicant's unique invention. Lastly, neither of these references are concerned with illumination of the motorcyclist's surrounding area at nighttime to improve the cyclist's visibility of the surroundings at night.

Claims 17, 27, 29 and 31 - Section 103(a) (Hamilton)

Claims 17 and 27 now state that the body member is adapted for attachment to a motorcycle frame. Hamilton fails to teach this feature. Hamilton also fails to illuminate the front adjacent surroundings to improve driver visibility. The illumination devices of Hamilton are used for the back lights of an automobile and have nothing to do with motorcycles.

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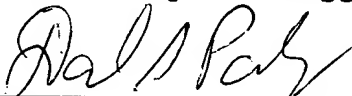
In view of the above, Applicant respectfully requests that the Examiner withdraw the current rejections.

Applicant has completely responded to the Office Action dated April 24, 2002.

In order to facilitate prosecution of this application, the Examiner is respectfully requested to contact the undersigned with any comments or suggestions the Examiner may have.

Any additional charges, including Extensions of Time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,  
Malin, Haley & DiMaggio, P.A.

By 

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